



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR      | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|---------------------------|---------------------|------------------|
| 09/423,684      | 03/20/2000  | MICHAEL ANTHONY CAWTHORNE | 00537/161002        | 7046             |

7590                    05/07/2003

Y ROCKY TSAO  
FISH & RICHARDSON  
225 FRANKLIN STREET  
BOSTON, MA 02110

[REDACTED] EXAMINER

ROBINSON, HOPE A

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

1653

DATE MAILED: 05/07/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |   |
|------------------------------|--------------------------------------|---|
| <b>Office Action Summary</b> | Application No.<br><b>09/423,684</b> | Applicant(s)<br><b>Cawthorne et al.</b> |
|                              | Examiner<br><b>HOPE ROBINSON</b>     | Art Unit<br><b>1653</b>                 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on Apr 25, 2003
  - 2a)  This action is FINAL.      2b)  This action is non-final.
  - 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- Disposition of Claims**
- 4)  Claim(s) 1-36 is/are pending in the application.
  - 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5)  Claim(s) \_\_\_\_\_ is/are allowed.
  - 6)  Claim(s) \_\_\_\_\_ is/are rejected.
  - 7)  Claim(s) \_\_\_\_\_ is/are objected to.
  - 8)  Claims 1-36 are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

***Restriction/Election***

1. Restriction is required under 35 U.S.C. 121 and 372.

5 This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

10

Group I. Claims 1-37 are drawn to a method of decreasing body weight and a specific somatostatin analog of SEQ ID NO:.

2. This application contains claims directed to the following patentably 15 distinct groups of the claimed invention of Group I: R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub> and A<sub>1</sub>, A<sub>2</sub>, A<sub>3</sub>, A<sub>6</sub>, A<sub>7</sub>, A<sub>8</sub> and several distinct somatostatin agonists, see for example, claims 24-25. The agonists are structurally and physically distinct, see for example, the sequence listing which exemplifies that SEQ ID NO:1 and 3 are structurally different. Applicant is required under 35 U.S.C. 121 to elect a single 20 disclosed invention for prosecution on the merits to which the claims shall be restricted. Furthermore, the composition contained in Group I does not escape the prior art because the prior art teaches a pharmaceutical composition which renders the invention of Group I as being anticipated/obvious (see Carretta et al., Journal of Hypertension, vol.7, pages 196-197, June 1989). As the 25 invention of Group I does not escape the prior art, the claimed invention is not linked by a special technical feature and thus lacks unity of invention.

Serial Number 09/423,684  
Art Unit 1653

3. A telephone call was made to Mr. Jeffrey Hsi on April 25, 2003 to request an oral election to the above requirement, but did not result in an election being made because the attorney had to contact the applicant.

5         Applicant is advised that the response to this election requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10         Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor-ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

15         Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hope A. Robinson whose telephone number is (703) 308-6231. The Examiner can normally be reached on Monday - Friday from 9:00 A.M. to 6:30 P.M. (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S.F. Low, can be reached at (703) 308-2923.

20         Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-2742. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Serial Number 09/423,684  
Art Unit 1653

5

Hope A. Robinson, MS

Patent Examiner

Christopher S. Low  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600